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REMARKS

Claims 23-28, 30-35, 37-38, 40-3 and 45 are currently pending in the subject application and are presently under consideration. Applicants' representative acknowledges with appreciation the Examiner's indication that independent claims 30, 38, and 44 are allowable. Claims 23, 40, and 43 have been amended as shown on pp. 2-6 of the Reply. Claim 44 has been cancelled. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 40-42 under 35 U.S.C. 102(b)

Claims 40-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Roach *et al.* (U.S. Pat. No. 5,310,997). This rejection should be withdrawn for at least the following reasons. Roach *et al.* does not teach or suggest all limitations set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

As noted in detail in previous Replies, the claimed invention relates to a shopping system for presenting data at a portable terminal by retrieving data files from a remote location using a wireless network. A customer using a portable terminal for shopping by "self-checkout" can receive marketing and pricing information from a central host for products scanned by the portable terminal. In particular, independent claim 40 recites *a messaging communication system having a receiver for receiving an electronic message generated by a customer comprising a shopping list of items to be purchased; at least one kiosk for maintaining the shopping list of items to be purchased, the kiosk comprising a*

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communication link with the messaging communication system for providing the shopping list based upon the message received from the customer; a self-scanning system comprising an interface for the customer to select one or more of the items to be purchased using a portable shopping terminal to maintain an updated list of selected items; and a plurality of checkout lanes to tender payment of the items selected for purchase by the customer. Roach *et al.* does not disclose or suggest these novel features of applicant's claimed invention.

In a section entitled "Claim Interpretation," the Examiner states that:

a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex Parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987)

Based on the above, the Examiner states that the structural limitations of claim 40 are respectively disclosed by Roach *et al.*: a communication system (Bridge PC 32 and Token Ring 34); a kiosk (scanners 220ABC); a self-scanning system (pen-based sales transaction computers 18); and a plurality of checkout lanes (pen-based sales transaction computers 18 and POS check-out registers 16). Apparently, the Examiner construes the remaining limitations as non-structural functional language. In response thereto, claim 40 has been amended to more positively recite the structure of the claimed invention. The claimed invention is a shopping facility with a beneficial and advantageous central communication system for facilitating customer self-shopping and check-out procedures. The invention includes a messaging communication system with positively-recited structural limitations for establishing communication with the customer and the kiosk, including a *portable shopping terminal* having an *interface* for the customer to communicate with the system, *e.g.* to update the shopping list, receive information on items or specials, and to self-checkout. It is clear that the cited elements of Roach *et al.* cannot be relied upon to show such invention features.

In view of the above, it is readily apparent that Roach *et al.* does not disclose or suggest a *communication system having a receiver for receiving an electronic message*,

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or a kiosk comprising a *communication link with the messaging communication system*, or a *portable self-scanning system comprising an interface for the customer*. In view of at least the foregoing comments, it is readily apparent that Roach *et al.* does not anticipate the subject invention as recited in claim 40 (and the claims that depend respectively there from.) Therefore, this rejection should be withdrawn.

II. Rejection of Claims 23-24, 27-28, 35, 37 and 43 Under 35 U.S.C. §103(a)

Claims 23-24, 27-28, 35, 37 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco (US 6,047,614) in view of PC EXPO or Internet Key to Link Key Services. Applicant's representative respectfully submits that this rejection should be withdrawn for at least the following reasons. The combination of Bianco and PC EXPO or Internet Key top Link Key Services fails to disclose or suggest all the features of the claimed invention with respect to independent claims 23 and 43.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* See MPEP §706.02(j). (Emphasis added). The teaching or suggestion to make the claimed combination and the reasonable expectation of success *must both be found in the prior art* and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

In the instant Office Action, independent claims 30 and 38 had been indicated allowable. Dependent claim 44 had been indicated as being allowable if put into independent form. The limitations of claim 44, *a portable shopping terminal used by a customer in the shopping facility*, have been incorporated into independent claim 43. Similar limitations are indicated allowable in the Reasons for Allowance of independent

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claims 30 and 38. Accordingly, independent claim 23 has been amended to recite similar limitations. In accordance with the indication of allowable subject matter, it is readily apparent that the combination of Bianco and PC EXPO or Internet Key to Link Key Services fails to make obvious the subject invention as recited in independent claims 23 and 43 (and claims that depend there from.) Therefore, this rejection should be withdrawn.

III. Rejection of Claims 25-26 Under 35 U.S.C. §103(a)

Claims 25-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco and PC EXPO or Internet Key to Link Key Services further in view of Roach *et al.* It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Bianco, PC EXPO, Internet Key to Link Key Services, nor Roach *et al.*, individually or in combination, teach or suggest all limitations recited in the subject claims.

It has been shown above that a combination of Bianco and PC EXPO or Internet Key to Link Key Services fails to disclose or suggest every limitation of the present independent claims. It is therefore respectfully submitted that dependent claims 25-26 distinguish for at least the same reasons as independent claim 23. But in any event, the Roach *et al.* reference fails to cure the deficiencies of the base combination, so even if these references could be combined as proposed by the Examiner, they would still fail to disclose or suggest every limitation of the claims. Therefore, this rejection should also be withdrawn.

IV. Rejection of Claims 31-34 Under 35 U.S.C. §103(a)

Claims 31-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco and PC EXPO or Internet Key to Link Key Services further in view of Gordon (US 5,608,786). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Bianco, PC EXPO, Internet Key to Link Key Services, nor Gordon, individually or in combination, teach or suggest all limitations recited in the subject claims.

It has been shown above that a combination of Bianco and PC EXPO or Internet

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Key to Link Key Services fails to disclose or suggest every limitation of the present independent claims. It is therefore respectfully submitted that dependent claims 31-34 distinguish for at least the same reasons as independent claim 23. But in any event, the Gordon reference fails to cure the deficiencies of the base combination, so even if these references could be combined as proposed by the Examiner, they would still fail to disclose or suggest every limitation of the claims. Therefore, this rejection should also be withdrawn.

IV. Rejection of Claim 45 Under 35 U.S.C. §103(a)

Claim 45 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Bianco and PC EXPO or Internet Key to Link Key Services further in view of Official Notice. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Bianco, PC EXPO, Internet Key to Link Key Services, nor the alleged well-known prior art, individually or in combination, teach or suggest all limitations recited in the subject claims.

It has been shown above that a combination of Bianco and PC EXPO or Internet Key to Link Key Services fails to disclose or suggest every limitation of the present independent claims. It is therefore respectfully submitted that dependent claim 45 distinguishes for at least the same reasons as independent claim 23. But in any event, the alleged well-known prior art fails to cure the deficiencies of the base combination, so even if these references could be combined as proposed by the Examiner, they would still fail to disclose or suggest every limitation of the claims. Therefore, this rejection should also be withdrawn.

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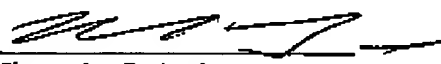
CONCLUSION

The subject application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
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